

Remarks:

Reconsideration of the application is requested. Claims 1-7, 16-19, 24, and 26-43 are now in the application. Claims 1, 5, 16-19, 24, and 26 have been amended. Claims 8-15, 20-23, and 25 have been canceled. Claims 32-43 are new. Claims 16-18 were previously withdrawn

The claims have been amended to better reflect the invention elected in the September 25, 2006, Election. Support for the amendments can be found in the specification in paragraphs [0052] to [0063] and Figs. 9-15.

In item 1 of the above-identified Office action, the Examiner has rejected the claims as containing subject matter that was not supported in the original specification as required under 35 U.S.C. § 112, first paragraph. More specifically, the Examiner has stated that the phrase, "Without mechanical force," lacked support. The phrase has been deleted from the claims. Therefore, the rejection is now moot.

Accordingly, the specification and the claims meet the requirements of 35 U.S.C. § 112, first paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In the fourth paragraph on page 3 of the Office action, the Examiner rejected claims 1-2, 4, 6-10, 19-20, 22, 24-29, and 31 as being fully anticipated by Holmes '701 under 35 U.S.C. § 102(b). The rejection has been noted and the claims have been amended in an effort to define more clearly the invention of the instant application. Support for the changes is found in paragraphs [0052] through [0063] of the specification and Figs. 9-15.

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Claim 1 calls for an apparatus for moving a medical implement through a tissue in a patient including, *inter alia*, the following:

a first tissue engaging surface being configured to hold the medical implement and to contact a first of the sides of the tissue;

a second engaging surface being movable relative to said first tissue in order to contact a second of the sides of the tissue and to penetrate the medical implement into the tissue;

a magnetizable material being disposed in one of said first and second tissue engaging surfaces; and

a magnetic field generator disposed in said tissue engaging surface not containing said magnetic element and generating a magnetic field to move said magnetic element relative to said magnetic field generator. (Emphasis added by Applicant.)

Holmes '701 col. 1, line 65, through col. 2, line 8, teaches a device having jaws for holding a needle. One of the jaws has a magnet embedded within it. The magnet attracts the needle to it causing the needle to move to a predetermined position on the jaw containing the magnet.

The held needle is then pushed through tissue. A second instrument, like the first, grabs the needle from the other side of the tissue and pulls the needle through the tissue. The relative strength of the magnets can be set to help move the needle. *Id.*, col. 2, ll 8-29.

Holmes '701 does not show a first tissue contacting surface that magnetically attracts a second tissue contacting surface to punch a medical implement through the tissue as recited in claim 1 of the instant application. In other words, the prior art teaches an attraction between a device and the needle. In contrast, the invention teaches a magnetic interaction between a first tissue-contacting surface and a second tissue-contacting surface to move the surfaces relative to each other especially in relation to tissue being held therebetween.

In the penultimate paragraph on page 4 of the Office action, the Examiner rejected claims 3, 5, 11, 21, 23, and 30 as being unpatentable over Holmes '701 in view of Berns '185 under 35 USC § 103(a). Berns '185 neither alone or in combination with Holmes '701 suggests a first tissue contact surface and a second tissue contact surface being magnetically manipulated to drive a medical implement through tissue.

Although Applicant does not believe that it is germane to the rejection, Applicant further distinguishes Bern '185 from the invention because Bern '185 merely suggests that an electromagnet can be used to replace a permanent magnet. Bern '185 does not teach that using such an electromagnet to change magnetic polarity can have the effect of attraction or repulsion. Therefore, Bern '185 does not suggest using an electromagnet to create a medical device that can be used to switchably attract or repulse another magnet.

Accordingly, none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Therefore, claim 1 is patentable over the art. Claims 26, 40 contain similar features as claim 1 and are patentable for the same reasons as claim 1. Moreover, because all of the dependent claims are ultimately dependent on claim 1, 26, or 40, they are believed to be patentable as well.

In light of the amendments to them and their new base claim, the rejoinder of claims 16-18 is requested.

In view of the foregoing, reconsideration and allowance of claims 1-7, 16-19-24, and 26-43 are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted.

Petition for extension is herewith made. The extension fee for response within a period of two months pursuant to Section 1.136(a) in the amount of \$230 in accordance with Section 1.17 for a small entity is enclosed herewith.

No fee is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 780-A04-002-1).

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'P. D. Bianco', with a stylized flourish at the end.

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